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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,331	07/10/2003	Ivan W. Grow	3188	2829
23618	7590	12/22/2003	EXAMINER	
CHASE & YAKIMO, L.C. 4400 COLLEGE BOULEVARD, SUITE 130 OVERLAND PARK, KS 66211			HESS, DANIEL A	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 12/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/617,331	GROW, IVAN W.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Daniel A Hess	2876	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 19-23 and 27 is/are rejected.
- 7) ☒ Claim(s) 15, 18, 24-26 and 28-32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____.  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Remarks*

Please note that filing of a terminal disclaimer can be used to overcome the double-patenting rejections in this action.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

**A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).**

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-14, 16-17 and 19-22 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 6-9 of U.S. Patent No. 6,462,302 (hereinafter '302) in view of Atchison (US 5,758,446).

Re claim 1: Claim 1 of '302 teaches all of the elements recited in instant claim 1 except that wherein in the '302 patent, a single marking is made on the bullet, in the instant claim, markings are made on both the slug and the case.

Atchison teaches (see claim 1, especially) that markings are simultaneously made on both the bullet itself and on the spent cartridge shell.

In view of Atchison, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include the old and well-known dual marking system (bullet and casing both) of Atchison in Grow, '302 because matching a casing with a bullet and a gun together can assist in solving gun related crimes.

Re claim 2: See claim 2 of '302.

Re claim 3: See claim 3 of '302. It follows that to mark the slug, the laser probe of '302 claim 3 would go in the barrel of the bore.

Re claim 4: See figures 10 and 11 of Grow.

Re claim 5: See claim 3 of '302. It follows that to mark the casing, the laser probe of '302 claim 3 would go into the breech of the bore.

Re claim 6: There are only a finite number of directions possible. It would have been obvious to etch in the claimed direction because this provides for longer lines of the bar code than other directions for easier scanning.

Re claim 7: Compare to claim 4 of '302. Same logic applies as was applied re claim 1 above.

Re claim 8: See claim 2 of '302.

Re claim 9: See '302, abstract: bar code is employed.

Re claim 10: See '302, figures 10 and 11.

Re claim 11: See claims 3 and 4 above.

Re claim 12: See columns 3, lines 19-21 of the '302.

Re claim 13: See column 3, lines 43-46.

Re claim 14: See claims 5 and 6 above.

Re claim 16: See claim 12 above.

Re claim 17: See claim 13 above.

Re claim 19: See claim 9 of '302. A stepper motor is a typical means of controlling movement.

Re claim 20: See column 3, lines 10-21 of '302: Clamping means are shown.

Re claim 21: See claim 8 of '302.

Re claim 22: See claim 9 of '302, and further see discussion re claims 4 and 6 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 23 and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Atchison.

Re claim 23: A basic system for reading bar code marked bullets is implied by Atchison.

A light source, detector, holder means, rotating means and microprocessor for identification would all be basic elements for such a system.

Re claim 27: Portability is very broad and most things are portable at some level.

### ***Allowable Subject Matter***

Claims 15, 18, 24-26 and 28-32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Re claim 15: Nowhere does the prior art teach or suggest variation in the depth of the grooves in the breech.

Re claim 18: Grow, '302 is the only art that teaches the claimed laser etching means, and '302 fails to teach the specific steps recited in claim 18.

Re claims 24-26 and 28-32: The prior art fails to directly teach a bullet bar code scanner, and while the existence of such a scanner is implied by Atchison, since it is not described

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directly, attempts to include the very specific features claimed in 24-26 and 28-32 tend one toward impermissible hindsight thinking.

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Zemsky (US 4,175,346) creates identifying markings on bullets.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A Hess whose telephone number is (703) 305-3841. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

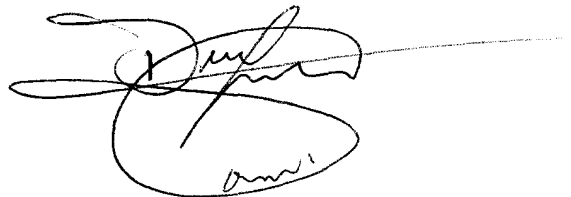
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

A handwritten signature in black ink, appearing to be 'DAH'.

DH

Daniel A Hess  
Examiner  
Art Unit 2876

A handwritten signature in black ink, appearing to be 'Daniel A Hess'.